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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,634	12/18/2000	Wilhelm Schmid	GR 98 P 1916 P	4357

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EXAMINER

PATEL, PARESH H

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/740,634

Applicant(s)

SCHMID ET AL.

Examiner

Paresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,8 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,9-13,17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 18 March 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/18/2003 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-4, 7, 9-13 and 17-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Election/Restrictions***

3. Claims 5-6, 8 and 14-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

### ***Drawings***

4. The corrected or substitute drawings were received on 03/18/2003. These drawings are not acceptable, because "a reference signal" and "a route with in the component" are not shown.

5. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "a reference signal" and "a route" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

6. The drawings also must show every feature of the invention specified in the claims. Therefore, the **route** within the integrated circuit component of claims 2 and 18; a component tester of claim 11; and a system of claim 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

7. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: 1) at least two **external test connecting**

**contact points** at lines 3-4 on page 5 and the **test connecting contact points** at lines 16-17 and 22 on page 5; 2) **housing 30** and **package 30**; 3) two **external test contact points** and **test contact points** on page 12.

### ***Claim Objections***

8. Claim 2 is objected to because of the following informalities: at line 1 of page 4 (paper no. 16) "said signals" should read --said electrical signals--. Appropriate correction is required.

9. Claims 2-4 and 10-13 are objected to because of the following informalities: at line 1 "integrated circuit" should read --integrated circuit component--.

10. Claims 11 and 12 are objected to because of the following informalities: at line 4 "signals at" should read --signals of--.

11. Claim 17 is objected to because of the following informalities: at lines 2 and 4 "integrated circuit" should read --integrated circuit component--.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for electrical signals can be selectively passed on to said at least one connecting contact point, does not reasonably provide enablement for

reference signals and said electrical signals can be selectively passed on to said at least one connecting contact point. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. In the specification it is clear that a reference signal is selectively (using what is not clear) applied to one of the connecting contact point for a circuit point but it is not clear how it relates to the electrical signals with one connecting contact point.

13. Claims 11-12 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 11, **A component tester** for analyzing the electrical signals is not disclosed. On page 10 of the disclosure applicant determines the goal, which is to determine the timing accurately but do not discloses the use of the **component tester** as disclosed in the claim.

Regarding claim 12, **A system** for analyzing the electrical signals is not disclosed. On page 10 of the disclosure applicant determines the goal, which is to determine the timing accurately but do not discloses the use of the **system** as disclosed in the claim.

Regarding claim 13, specification do not support connecting contact point is used for analyzing a system in which said integrated circuit is used.

Regarding claim 18, it is not clear how **a reference signal** is related to an **electrical signals**? They raises following concern and/or questions: 1) If they both are related, then they don't have support on specification (see description of fig. 1); 2) If they are not related, what is the use of the reference signal?

All the claims which depends from above rejected claims are also rejected.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: 1) what generates reference signals? and 2) what selects reference signals? (so they can be selectively passed on to said at least one connecting contact point. Here, multiplexer receives plurality of electrical signals at its inputs and outputs only one electrical signal to the connecting contact point).

15. Claims 2, 11-13 and 18 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, relation between reference signals, connecting contact point, multiplexer and electrical signals are not clear.

Regarding claim 11, relation between component tester and electrical signals with plurality of circuit points are not clear.

Regarding claim 12, relation between a system and electrical signals with plurality of circuit points are not clear.

Regarding claim 13, it is not clear how connecting contact point is used to for analyzing a system in which said integrated circuit is used.

Regarding claim 18, it is not clear how **a reference signal** (passes on to one of the first plurality of circuit points) related to an **electrical signals** (provided from second plurality of circuit points to said second connecting contact point)?

16. All the claims, which depend from above rejected claims, are also rejected.

**17. Examiner can't provide prior art to claims rejected under 35 USC 112 because the scope of these claims is not clear for the above given reason(s).**



***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Palagonia (US 5895978).

Regarding claims 1 and 17, Palagonia in fig. 2 discloses: an integrated circuit component [40], comprising:

a first plurality of circuit points (plurality of circuit points of claim 1) [46 with 42A] not being externally accessible;

a second plurality of circuit points [46 with 44] not being externally accessible;

a first connecting contact point (at least one connecting contact point of claim 1) [42A] being externally accessible;

a second connecting contact point [next to 42A] being externally accessible;

a first multiplexer (a multiplexer of claim 1) [MUX of 46 with 42A] having an output [output of MUX to 42A] connected to said first connecting contact point (at least one connecting contact point of claim 1) and having a plurality of inputs [from 46], each one of said plurality of inputs being connected [via 52] to a respective one of said first plurality of circuit points (plurality of circuit points) [46].

a second multiplexer [MUX 44] having an output [output of MUX 44] connected to said second connecting contact point and having a plurality of inputs [from 46 or I/O],

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each one of said plurality of inputs being connected [via 52] to a respective one of said second plurality of circuit points [46 with 44].

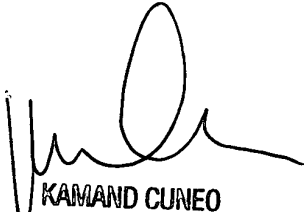
### ***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paresh Patel whose telephone number is 703-306-5859. The examiner can normally be reached on M-F (8:30 to 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kammie Cuneo can be reached on 703-308-1233. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Paresh Patel  
May 29, 2003



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